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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/936,304	09/24/97	DONG	D 15758.705

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EXAMINER	
SCOTT JR,L	
ART UNIT	**PAPER NUMBER**
2881	

DATE MAILED: 01/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	08/936,304	DONG, DAWEI	
	Examiner	Art Unit	
	:Leon Scott Jr.	2881	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 December 2000* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15)☐ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18)☒ Interview Summary (PTO-413) Paper No(s). *15.5* .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other: .

The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided *the conflicting application or patent is shown to be commonly owned with this application.* See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U. S. Patent No. 5,754,582. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 3 of the patent substantially recites the subject matter of claim 6 of the application as follows: ..

Patent Serial No. 5,754,582	Application Serial No. 08/936,304
Claim 3: A laser system comprising a module housing including: main shaft defining an axis of rotation and a cylindrical hole with a center axis which lies in a plane perpendicular to the axis of rotation; a case with a bearing to support the main shaft , wherein the main shaft is in the bearing; a motor wherein the motor is coupled to the main shaft; and a rotatable laser diode module which generates coherent light, wherein the rotatable laser diode module is in the cylindrical hole of the module housing, wherein the rotatable laser diode module projects a laser beam along a center ray, wherein the center ray of the laser beam and the center axis define an angle Θ and wherein the angle Θ lies within the plane which is perpendicular	Claim 6(Amended): A laser level system comprising: a rotating shaft; a motor coupled to the shaft adapted to drive the shaft more than 360 degrees in a single direction; an upper case rotatably supporting the rotating shaft; and a module housing attached to the rotating shaft, the module housing containing a laser diode projecting a beam having a center ray. wherein the center ray of the beam is perpendicular to the rotating shaft.000...

to the axis of rotation of the main shaft.	

When one compares the claims of the patent with those of the application it is clear that the 360 degree rotation of the shaft is ***inherent*** in the device of the patent claims.

The amendment filed 8/23/00 is objected to under 35 U.S.C. 132 because it introduces *new matter* into the specification. 35 U.S.C. 132 states that *no amendment* shall introduce new matter into the disclosure of the invention.

Claim 6 is rejected under 35 U.S.C. 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention Indeed there does not appear to be a written description of the claim limitation that the motor is "***adapted to drive the shaft more than 360 degrees in a single direction***". Thus the added material which is not supported by the original disclosure is that the motor is: "***adapted to drive the shaft more than 360 degrees in a single direction***", accordingly lines 3 and 4 of claim 6 constitute ***new matter***.

Applicant states in his response to the holding of *new matter* that, "*Since the free wheel 32 is attached to the main shaft 37 , the shaft 37 travels many rpm, and clearly more than 360 degrees".* The facts are that this *conclusion* that *the shaft 37 travels many rpm, and clearly more than 360 degrees* constitutes nothing more than an attempt to justify a lack of disclosure. Indeed the plane of laser light generated by the level could readily be achieved by rotating the laser level in 180 degree increments in one direction to produce the plane of light. Of course this is speculation on the part of the examiner, ,just as applicants position is speculation ; however both positions may be viable because nothing has been disclosed which would support applicant's position over that of the examiners. Should applicant care to submit an affidavit attesting to what one of ordinary skill in the art would consider disclosed by the application as originally filed the question of support still persists ***Again*** ,applicant is requested to point out where in the specification ***support*** for this ***exact*** recitation can be found. It is pointed out that applicant's response to this request(see Amendment D dated 12/22/00) is not convincing of support for this recitation,. thus the rejection remains in force.

Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the preamble of all of claims 6-10 applicant ***now*** attempts to *change the scope of his invention* by inserting the word ***level*** after laser so that all claims are to *A laser **level** system.* In response to applicant's arguments, the recitation to: *A laser **level** system.* has not been given patentable weight because the recitation occurs in the **preamble**. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim ***does not*** depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further since no connective relationships have been recited in claim 6 between a laser

level and the system components, claim 6 is indefinite and incomplete. In line 8 of claim 6 it is not clear how the upper case ***rotatably*** *supports* the rotating shaft, claim 6 is indefinite and incomplete.

Claim 6 is, insofar as definite is rejected under 35 U.S.C. 102**(b)** as ***anticipated*** by or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Kirchever et al('120) or over Kirchever et al('948), both as applied in the previous rejection of claim 6(see rejection dated 09/21/00).

Applicant's arguments filed 12/22/00 have been fully considered but they are not persuasive

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Léon Scott Jr. at telephone number (703)308-4884.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Léon Scott, Jr.
Primary Examiner
Art Unit 2881

January 28, 2001